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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WILLIS, MICHAEL A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,463

Applicant(s)

AVALLE, NADIA

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment of 1 November 2002 is entered. Claims 1, 7, 10, and 12 are amended. Claims 1-3 and 6-17 are pending. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

All previous rejections under 35 USC 112, 2nd paragraph are withdrawn in response to Applicant's amendment. It is noted that the function of "functional substances" is read broadly as any function.

The following rejections are maintained:

Response to Arguments

Claims 1-3, 6-7, 9, and 14-17 are rejected under 35 USC 102(e) as being unpatentable over Elwakil (US Pat. 6,187,439) for reasons as stated previously.

Applicant argues that the hydroxy acids of the coating could not interact with skin if the particles were placed on the skin because the compositions are used for printing inks or magnetic recording systems and that the shell wall materials solidify and encapsulate the particles with a hydrophobic shell. Thus, the coating is described as solid, and the hydroxy material incorporated therein could not interact with skin. Applicant further asserts that the method of claim 10 is clearly not taught by Elwakil.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the feature upon which applicant relies (i.e., the incorporated hydroxy material having the capacity to interact with skin) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims state "whereby said **coating** can interact with the skin". The term "interact" is given its broadest reasonable interpretation. As such, the term includes any kind of chemical or physical association between the coated particles and skin. Therefore, any two items that can be brought into physical contact with each other necessarily meet the limitation of being able to interact with each other. While the compositions of Elwakil are not intended to be used in the same manner as the claimed compositions, intended use is not given patentable weight, and there is nothing to physically prevent the compositions from being brought into contact with skin. Therefore, the compositions of Elwakil inherently meet the limitation of "whereby said coating can interact with skin".

Applicant's argument with respect to claim 10 amounts to a general allegation that the claim defines a patentable invention without specifically pointing out how the language of the claim patentably distinguishes it from the references.

Claims 1-3 and 6-17 are rejected under 35 USC 103(a) as being unpatentable over Gustafsson et al (US Pat. 6,120,787) for reasons as stated previously.

Applicant argues that the shell taught by Gustafsson is biodegradable over a period of days or weeks, and designed to break down within the body rather than serve as a cosmetic powder which is typically washed off after 12-16 hours use at most. Applicant further asserts that the method of preparing a cosmetic powder is clearly not taught by Gustafsson.

Applicant's argument is not convincing in that the feature upon which applicant relies (i.e., the incorporated hydroxy material having the capacity to interact with skin within 12-16 hours) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Rather, the claims state "whereby said **coating** can interact with the skin". The term "interact" is given its broadest reasonable interpretation. As such, the term includes any kind of chemical or physical association between the coated particles and skin. Therefore, any two items that can be brought into physical contact with each other necessarily meet the limitation of being able to interact with each other. While the compositions of Gustafsson are not intended to be used in the same manner as the instant compositions, intended use is not given patentable weight, and there is nothing to physically prevent the compositions from being brought into contact with skin. Therefore, the compositions of Gustafsson inherently meet the limitation of "whereby said coating can interact with skin".

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Applicant's argument with respect to claim 10 amounts to a general allegation that the claim defines a patentable invention without specifically pointing out how the language of the claim patentably distinguishes it from the references.

The following new grounds of rejection are made:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 and 6-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a "new matter" rejection.

The new matter introduced by amendment is the limitation "whereby said coating can interact with the skin of a wearer when said cosmetic powder is applied to the skin" in claims 1 and 10. Support for the term "interact" could not be found in the specification or claims as filed. Furthermore, the term "interact" is given its broadest reasonable interpretation. As such, the term includes any kind of chemical or physical association between the coated particles and skin. Such an interpretation encompasses not just degradation of the coating to release monomers onto the skin, but also other types of association such as simple physical contact or even chemical bonding between the

coating and proteins in the skin. Support for such types of association could not be found in the specification or claims as filed.

Removal of the new matter is required.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30 pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

maw
January 15, 2003



THEODORE J. CRIARES
PRIMARY EXAMINER
GROUP 1200/600